

## **REMARKS**

Applicant respectfully requests that the Examiner consider the claims as amended in this Amendment for examination purposes. Entry of this Amendment is respectfully requested.

### **1. Status of the Claims**

Claims 1-13 stand pending. Claims 1-13 stand rejected. Upon entry of the present amendments, Applicants (1) cancel claims 1-13, and (2) newly introduce claims 14-28. Support for the amendment can be found at least, for example, from the originally filed claims.

Specifically, support for the recitation of a "further grinding" step in claims 14 and 22 can be found at least, for example, from lines 4-7 on page 9 of the Specification. Support for the recitation of "not less than about 50% of the particles" in claims 14 and 22 can be found at least, for example, from lines 27-28 on page 9 of the Specification. Support for the use of "a high pressure homogenizer" in claims 15 and 23 can be found at least, for example, from lines 4-5 on page 9 of the Specification. Support for the recited pressure range in claims 16 and 24, *i.e.*, "about 10 MPa to about 15 MPa," can be found at least, for example, from lines 10-11 on page 9, and lines 26-27 on page 12 of the Specification. Support for the use of centrifugation in claims 17 and 25 can be found at least, for example, from lines 3-4 on page 10 of the Specification. Support for the recited blending ratio of "about 1:1 to about 1:10" in claim 19 can be found at least, for example, from lines 11-14 on page 11 of the Specification. Support for the recited amount of water or tea extract added to the powdered tea in claims 14 and 26, *i.e.*, "about 5 to about 50 parts," can be found from lines 24-26 on page 8 of the Specification. Support for "adding a tea extract to the obtained powdered tea" can be found at least, for example, from lines 27-28 on page 8 of the Specification. Accordingly, Applicants submit that no impermissible new matter is introduced by entry of the present amendment.

The claims have been amended without prejudice to, or disclaimer of, the canceled subject matter. Applicants reserve the right to file a continuation or divisional application on any subject matter canceled by way of amendments.

**2. Acceptance of Formal Drawings**

Applicants note with appreciation the indication that the formal drawings filed December 15, 2005, are deemed acceptable.

**3. Acknowledgement of Information Disclosure Statements**

Applicants note with appreciation the acknowledgement of the Information Disclosure Statements submitted December 15, 2005; November 28, 2006; and September 21, 2007.

Applicants herewith submit an Information Disclosure Statement containing (1) a partial English translation (verified) of Yutaka et al. JP 08-116881, and (2) a partial English translation (verified) of Yoshiyuki et al. JP 11-276074. Please note that the references have been included in the previously filed Information Disclosure Statements submitted September 21, 2006 and December 15, 2005, respectively.

**4. Acknowledgement of Priority Documents**

Applicants note that the Office has yet to acknowledge the claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f) and receipt of all the certified copies. Applicants respectfully request such acknowledgement with the Office's next communication.

**5. Rejection of the Claims Under 35 U.S.C. § 112, Second Paragraph**

The Office rejects claims 1-13 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office asserts that the following terms or phrases render the claims indefinite:

- 1) "most of the particles" in claims 1, 3-7, and 9-10;
- 2) "fine" in claims 1, 3-4, 6, and 9-10; and
- 3) "ultrafine" in claims 1, 5, 7-8, and 11.

Office Action, page 2.

Applicants respectfully traverse the rejection to the extent it applies to the amended claims. Upon entry of the present amendments, claims 1-14 stand canceled, mooted the rejection. Furthermore, the above-listed terms or phrases are absent in the newly introduced

claims 14-31. Accordingly, Applicants respectfully request withdrawal of the indefiniteness rejection and allowance of the claims.

**6. Rejection of the Claims Under 35 U.S.C. § 102(b)**

The Office rejects claim 1 under 35 U.S.C. § 102(b) as allegedly being anticipated by **Yoshiyuki** et al. (JP 11-276074 – machine translation) [hereinafter “Yoshiyuki”]. The Office asserts that Yoshiyuki discloses “a fine ground tea dispersion and a tea beverage produced by removing most of the particles less than 1  $\mu$ m in diameter (Abstract, [0014], [0018]).” Office Action, page 3. The Office also notes that Yoshiyuki *does not* disclose grinding the tea. *Id.*

Applicants traverse the rejection to the extent it applies to the amended claims. To anticipate a claim, the prior art must disclose each and every element of the claim explicitly or inherently. *See In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993).

Upon entry of the present amendments, claim 1 stands canceled, mooted the rejection. Moreover, both the newly introduced independent claims 14 and 22 recite (1) **grinding** a tea raw material, and (2) further **grinding** the powdered tea. These two elements are incorporated in all dependent claims. Because the Office admits that Yoshiyuki at least fails to teach grinding the tea, at least one claim element is not taught by the alleged reference. *Id.* Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

**7. Rejection of the Claims Under 35 U.S.C. § 103(a)**

The Office rejects claims 1-10 and 12-13 under 35 U.S.C. § 103(a) as allegedly being unpatentable over **Yutaka** et al. (JP 08-116881 – Abstract only) [hereinafter “Yutaka”] in view of Yoshiyuki. The Office further rejects claim 11 under 35 U.S.C. § 103(a) over Yutaka in view of Yoshiyuki and further in view of **Fu** et al. (U.S. Patent No. 5,827,560) [hereinafter].

As to the Yutaka-Yoshiyuki combination, the Office admits that Yutaka fails to disclose removing most of the particles greater than 1  $\mu$ m. Office Action, page 5. Yutaka is asserted for teaching a fine powder tea having  $\leq 10 \mu$ m average particle diameter produced by powdering (*i.e.*, grinding) a tea raw material and subjecting the preliminary powdered tea to we pulverization by a high pressure homogenizer. *Id.* Yoshiyuki is asserted for teaching a tea beverage made from a fine powder tea that has excellent flavor. *Id.* Yoshiyuki is alleged to

teach that the tea is produced by centrifuging a fine powdery tea dispersion to remove larger particles and leave particles of 1  $\mu$ m or less in diameter. *Id.* The Office combines the references arguing that it is the same area, *i.e.* beverages made with fine powdery tea. Office Action, pages 6-9.

As to the Yutaka-Yoshiyuki-Fu combination, the Office asserts Yutaka for the reasons discussed above. The Office admits that Yutaka does not teach blending the ground tea dispersion with a tea extract. Office Action, page 9. Fu is asserted for teaching "a tea extract containing soluble tannins having good color (Abstract). Further, Fu et al. teach a diluted tea beverage made from the tea extract (Examples 1-7)." *Id.*

Applicants respectfully traverse the obviousness rejections to the extent they apply to the amended claims. Upon entry of the present amendments, claims 1-13 stand canceled, mooted the rejection. Furthermore, the newly introduced claims are non-obvious over the cited art, and thus patentable.

A finding of obviousness under 35 U.S.C. § 103 requires a determination of the scope and content of the prior art, the differences between the invention and the prior art, the level of ordinary skill in the art, and whether the differences are such that the claimed subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966); and *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 82 U.S.P.Q.2d 1385 (2007). "[O]bviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342, 68 U.S.P.Q.2d 1940, 1947 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974)). The combination of references must provide the artisan with a reasonable expectation of success in pursuing a particular line of inquiry. *See In re O'Farrell*, 853 F.2d 894, 903, 7 U.S.P.Q.2d 1673, 1681 (Fed. Cir. 1988).

The newly introduced claim 14 recites, *inter alia*, blending the ground tea dispersion with a tea extract, *i.e.*, the "blending" element. This element is accordingly incorporated in all dependent claims. The Office admits that Yutaka at least fails to teach blending the ground tea dispersion with a tea extract to produce a tea beverage. Office Action, page 8. Yoshiyuki teaches, at best, making a tea beverage from a fine power tea and preparing an extract with a fine powdery tea by removing particles using centrifugation. *Id.* Yoshiyuki thus fails to teach the

“blending” element. On the other hand, the process for producing a tea extract taught by Fu comprises:

- i) extracting tea solids from tea leaves using an extraction liquid to provide a tea extract containing soluble tea solids and insoluble tannins;
- ii) separating the insoluble tannins from the tea extract to obtain a clarified tea extract;
- iii) oxidizing and solubilizing the tannins under raised temperature conditions to provide a solubilized tannin liquor; and
- iv) adding the solubilized tannin liquor to the extraction liquid during extraction of tea solids from tea leaves in step i); and
- v) collecting the clarified tea extract of step ii) to obtain a tea extract which contains solubilized tea tannins.

See e.g., claim 1 of Fu. In Fu’s method, solubilized tannins are added to a tea extract. The solubilized tannins are produced by oxidizing insoluble tannins in a tea extract, which is *free of tea leaves*. Similarly, solubilized tannins do not contain tea leaves, nor do they contain ground tea leaves. Accordingly, the tea extract taught by Fu does not contain ground tea leaves. Thus, Fu fails to teach the “blending” element, which necessarily indicates the present of powdered tea leaves in the recited beverage.

The newly introduced claims 14-19 are thus non-obvious over (1) Yutaka-Yoshiyuki, or (2) Yutaka-Yoshiyuki-Fu combination, because the references, alone or viewed in combination, fails to teach or suggest all claim elements. See *CFMT*, 349 F.3d at 1342, 68 U.S.P.Q.2d 1947. As not all elements are taught by the cited art, there is accordingly no reasonable expectation of success. See *O’Farrell*, 853 F.2d at 903, 7 U.S.P.Q.2d at 1681.

The newly introduced claim 22 recites, *inter alia*, adding a tea extract to the powdered tea and further grinding the powdered tea, i.e., the “tea-extract/grinding” element. This element is accordingly incorporated in all dependent claims. Yutaka discloses, at best, that powdered tea leaves are suspended in *water* or water containing crystalline cellulose and treated with a NANOMIZER to obtain fine ground tea suspension. See ¶¶ [0019], [0027], [0030], [0032], and [0036] in a partial English translation of Yutaka. Yoshiyuki discloses, at best, that pulverized green tea leaf was subject to wet pulverization by the NANOMIZER. See ¶ [0038] in a partial English translation of Yoshiyuki. Yoshiyuki does not mention the liquid material used in the wet pulverization. Fu, as discussed *supra*, fails to teach this “tea-extract/grinding” element, because Fu does not teach adding a tea extract to the powdered tea.

New claims 20-26 are thus non-obvious over (1) Yutaka-Yoshiyuki, and/or (2) Yutaka-Yoshiyuki-Fu combination, because the references, alone or viewed in combination, fail to teach or suggest all claim elements. *See CFMT*, 349 F.3d at 1342, 68 U.S.P.Q.2d 1947. As not all elements are taught by the cited art, there is accordingly no reasonable expectation of success. *See O'Farrell*, 853 F.2d at 903, 7 U.S.P.Q.2d at 1681.

In view of the above arguments, the new introduced claims are patentable over either (1) Yutaka-Yoshiyuki, or (2) Yutaka-Yoshiyuki-Fu combination. Applicants respectfully request withdrawal of the obviousness rejection and allowance of the claims..

**CONCLUSION**

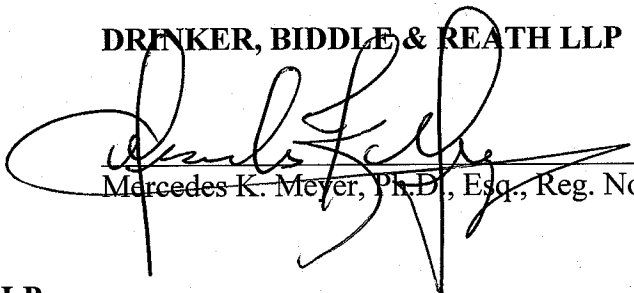
Should the Examiner have any questions or comments regarding Applicants' amendments or response, please contact Applicants' undersigned representative at (202) 842-8821. Furthermore, please direct all correspondence to the below-listed address.

In the event that the Office believes that there are fees outstanding in the above-referenced matter and for purposes of maintaining pendency of the application, the Office is authorized to charge the outstanding fees to Deposit Account No. 50-0573. The Office is likewise authorized to credit any overpayment to the same Deposit Account Number.

Respectfully submitted,

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